

REMARKS

The Office Action dated September 23, 2005, has been received and reviewed.

Claims 1-20 are currently pending in the above-referenced application. Claims 1-9 and 11-20 have been considered and stand rejected. Claim 10 has been withdrawn from consideration pursuant to an election of species requirement.

Reconsideration of the above-referenced application is respectfully requested.

Request for Reference Numerals

The Examiner's request for reference numerals that correspond to various elements of the claims is respectfully declined, as the claims of the above-referenced application are directed to methods, not to the apparatus illustrated in the drawings of the above-referenced application. In any event, without limiting the scope of any of the pending claims, Fig. 4 schematically depicts various aspects of several claims of the above-referenced application.

Supplemental Information Disclosure Statement

Please note that a Supplemental Information Disclosure Statement was filed in the above-referenced application on April 18, 2005, but that the undersigned attorney has not yet received any indication that the references cited in the Supplemental Information Disclosure Statement have been considered in the above-referenced application. It is respectfully requested that the references cited in the Supplemental Information Disclosure Statement of April 18, 2005, be considered and made of record in the above-referenced application and that an initialed copy of the Form PTO/SB/08A that accompanied that Supplemental Information Disclosure Statement be returned to the undersigned attorney as evidence of such consideration.

Obviousness-Type Double Patenting Rejection

Claims 1-20 have been rejected under the judicially created doctrine of obviousness-type double patenting for being directed to subject matter that is purportedly unpatentable over the subject matter recited in claims 1-20 of copending U.S. Application Serial No. 10/035,738.

A terminal disclaimer and the appropriate fee were already filed in the above-referenced application. Thus, the obviousness-type double patenting rejection of claims 1-20 is no longer appropriate.

Rejections under 35 U.S.C. § 103(a)

Claims 1-9 and 11-20 stand rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Umbaugh

Claims 1-9 and 14-17 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over the subject matter taught in U.S. Patent 3,855,693 to Umbaugh (hereinafter "Umbaugh").

Umbaugh discloses a process by which cantilevered leads that comprise ferromagnetic material are magnetically drawn toward corresponding terminals of a substrate while the leads are permanently secured to their corresponding terminals. *See, e.g.*, col. 7, lines 40-54; col. 4, line 44, to col. 5, line 6. Umbaugh includes no teaching or suggestion that such drawing is useful for maintaining an electrical contact.

It is respectfully submitted that there are several reasons that Umbaugh does not support a *prima facie* case of obviousness against any of claims 1-9 or 14-17.

First, Umbaugh includes no teaching or suggestion that the cantilevered leads disclosed therein may be drawn toward corresponding terminals of a substrate “to at least temporarily maintain [an] electrical contact,” as required by independent claims 1 and 8.

Second, without the benefit of hindsight that the specification and claims of the above-referenced application provide to the Examiner, one of ordinary skill in the art wouldn’t have been motivated to modify teachings from Umbaugh to techniques in which a first member of an electrical connector is drawn toward a contact to at least temporarily maintain an electrical contact therebetween. That is because Umbaugh merely teaches that leads may be drawn toward contacts so that solder or another suitable conductive bonding medium may electrically connect the leads to the terminals of a substrate.

Third, one of ordinary skill in the art would have no reason to expect that the asserted modification of teachings from Umbaugh would be successful. That is because Umbaugh does not provide one of ordinary skill in the art that the manner in which cantilevered leads are drawn toward corresponding terminals is sufficient to establish, let alone at least temporarily maintain, an electrical contact between the leads and their corresponding terminals.

As a *prima facie* case of obviousness has not been established, under 35 U.S.C. § 103(a), the subject matter recited in independent claims 1 and 8 is allowable over the teachings of Umbaugh.

Each of claims 2-7 is allowable, among other reasons, for depending directly or indirectly from claim 1, which is allowable.

Claims 9 and 14-17 are each allowable, among other reasons, for depending directly from claim 8, which is allowable.

Umbaugh in View of Butherus

Claims 11-13 have been rejected under 35 U.S.C. § 103(a) for being drawn to subject matter that is allegedly not patentable over the subject matter taught in Umbaugh, in view of teachings from U.S. Patent 3,612,955 to Butherus et al. (hereinafter “Butherus”).

The teachings of Butherus relate to use of magnetism to align leads with their corresponding terminals of a carrier substrate. The leads are then permanently bonded (*e.g.*, with

solder) to the terminals to establish and maintain electrical contact therebetween. Col. 2, lines 71-75.

In view of its limited teachings, it is respectfully submitted that Butherus does not remedy any of the aforementioned deficiencies of Umbaugh with respect to establishing a *prima facie* case of obviousness. Specifically, neither of these references teaches or suggests that a first member of an electrical connector may be drawn toward at least one contact to at least temporarily maintain an electrical contact therebetween. Thus, Umbaugh and Butherus do not teach or suggest each and every claim element, provide one of ordinary skill in the art with any motivation to combine their teachings in a way that would render the claimed subject matter obvious, or provide one of ordinary skill in the art with any reason to expect that any combination of their teachings would successfully result in the claimed methods.

In any event, claims 11-13 are allowable for depending directly or indirectly from claim 8, which is allowable.

Umbaugh in View of Official Notice

Claims 18-20 are rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over teachings from Umbaugh, in view of teachings of which the Office purports it can take “official notice.”

Claims 18-20 are allowable, among other reasons, for depending indirectly from claim 8, which is allowable.

Election of Species Requirement

In the Office Action of July 25, 2003, it was noted that “[if] independent claim 8 is allowed, [withdrawn] claim 10 will be rejoined.” In view of the allowability of independent claim 8, it is respectfully requested that claim 10 be considered and allowed. *See also* M.P.E.P. § 806.04(d).

CONCLUSION

It is respectfully submitted that each of claims 1-20 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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